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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,510	02/16/2006	Jan Buberl	06900128PUS1	1191

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EXAMINER	
BROOKS, KRISTIE LATRICE	

ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
05/26/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/568,510	BUBERL ET AL.	
	Examiner	Art Unit	
	KRISTIE L. BROOKS	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. Claims 1-14 are pending.

2. Receipt and consideration of Applicants amendments/remarks February 18, 2010 is acknowledged.

3. Applicant has amended claim 1 to incorporate "consisting essentially of" language in the claim. Therefore, due to the Applicant's amendment of claim 1, the Examiner has performed a new search and a new around of rejection is presented below.

4. Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

New Grounds of Rejection Necessitated by Applicant's Amendment

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 5,330,995).

Application Claims

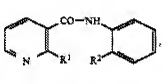
Applicant claims a method for regulating plant growth, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective amount of growth regulator, wherein said growth regulator consists essentially of a compound having the formula I

A-CO-N R^1R^2.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Eicken et al. (US 5,330,995) teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I or formula III



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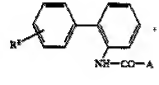


III

or

(see the abstract, column 1 lines 1-44, column 10 lines 20-67, and column 11 lines 1-8 and 47-56). The compounds are useful for controlling the fungi Botyris (see the abstract). The compounds can be formulated into compositions in the form of sprayable solutions, powders, suspensions, granules by dusting, broadcasting, etc. (see column 29 lines 60-68). The formulations are produced with a carrier or solvent (see column 30 lines 6-68). The active compound is present in an amount of 0.5 to 95% by weight (see column 32 lines 35-37). The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 32 lines 1-11). The fungicidal composition can be applied at rates from 0.021 to 3 kg, of active compound per ha or 0.001 to 50g per kg of seed (see column 32 lines 35-43). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 32 lines 44-68, and columns 33-34).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Eicken et al. (US 5,330,995) teach the instantly claimed compounds of formula I but do not exemplify applying a compound of formula I or formula III to said plants.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

One of ordinary skill in the art would have been motivated apply the instant compounds of formula I to said plants because Eicken et al. (US 5,330,995) suggest the application of the same instant compounds to plants for controlling fungi.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the instant compounds of formula I to said plants because it is an obvious variation of compounds that are capable of treating the plants against fungal attacks that may damage or destroy crops, thereby regulating the growth of said plants.

With respect to the instant limitation, "i.e. A method of regulating plant growth…", it is the Examiner's position that since there is not difference between the materials, amount used, or method steps recited in the instant claims and prior art reference Eicken et al. (US 5,330,995), the instant limitation will inherently be met upon application to said plant. Furthermore, one of ordinary skill can reasonably assume that since the compounds are being used to protect susceptible plants against fungal attacks that may damage crops, an increase in grow of the plants will ultimately occur.

With respect to claim 6 and the plant growth regulating effects, it is the Examiners position that since the prior art teaches the same compounds in the same amount instantly claimed, the plant growth regulating effects instantly claimed will implicitly occur upon application to the plant.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

7. Claims 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 5,330,995) in view of Eicken et al. (US 6,143,745).

Application Claims

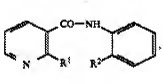
Applicant claims a method for regulating plant growth, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective amount of growth regulator, wherein said growth regulator consists essentially of a compound having the formula I

A-CO-N R^1R^2.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Eicken et al. (US 5,330,995) teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I or formula III



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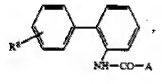


III

or

(see the abstract, column 1 lines 1-44, column 10 lines 20-67, and column 11 lines 1-8 and 47-56). The compounds are useful for controlling the fungi Botyris (see the abstract). The compounds can be formulated into compositions in the form of sprayable solutions, powders, suspensions, granules by dusting, broadcasting, etc. (see column 29 lines 60-68). The formulations are produced with a carrier or solvent (see column 30 lines 6-68). The active compound is present in an amount of 0.5 to 95% by weight (see column 32 lines 35-37). The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 32 lines 1-11). The fungicidal composition can be applied at rates from 0.021 to 3 kg, of active compound per ha or 0.001 to 50g per kg of seed (see column 32 lines 35-43). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 32 lines 44-68, and columns 33-34).

Ascertainment of the difference between the prior art and the claims

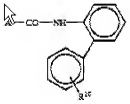
(MPEP 2141.02)

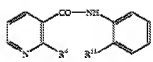
Eicken et al. (US 5,330,995) teach the instant compounds of formula I can be applied to plants with other fungicides in order to broaden the spectrum of activity against fungi but do not teach strobilurin fungicides. This deficiency is cured by the teachings of Eicken et al. (US 6,143,745).

Eicken et al. (US 6,143,745) teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I

A-CO-N R^1R^2

(see the abstract, column 2 lines 63-67 and column 3 lines 1-26). The compositions can preferably contain a compound of formula Ia or Ib





(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The compositions are particularly useful against a broad spectrum of phytopathogenic fungi, in particular against Botyris. The active compound is present in an amount of 0.1 to 95% by weight (see column 10 lines 63-65). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48).The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active compound per ha or 0.001 to 50g per kg of seed (see column 10 lines 66-67 and column 11 lines 1-3). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[α-(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[α-(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The

compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

One of ordinary skill in the art would have been motivated apply a compound of formula I and a strobilurin to said plants because Eicken et al. (US 5,330,995) suggest that the instant compounds of formula I can be combined with other fungicides in order to broaden the spectrum of fungicidal activity, in particular against Botyris. Although Eicken et al. (US 5,330,995) do not teach that strobilurins can be combined with the instantly claimed compounds of formula I, Eicken et al. (US 6,143,745) do suggest that the instant claimed strobilurins can be combined with the instantly claimed compounds in order to increase the fungicidal spectrum of activity. Eicken et al. (US 6,143,745) further suggest that the fungicidal compositions comprising strobilurins can be combined with the instantly claimed compounds of formula I are particularly useful against the fungi, Botyris.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the instantly claimed compounds of formula I and strobilurins to said plants to kill fungi because it is known in the art to combine the instantly claimed compounds and strobilurins in the treatment of fungi (i.e. Botyris) and because strobilurins are an obvious variation of compounds that are capable of protecting plants against fungal attacks that may damage or destroy crops.

Furthermore, one of ordinary skill in the art would have used the combination if one wanted to broaden the protection against fungi.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 5,330,995) in view of Eicken et al. (US 6,143,745), further in view of Asrar et al. (US 2003/0060371).

Application Claims

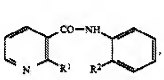
Applicant claims a method for regulating plant growth, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective amount of growth regulator, wherein said growth regulator consists essentially of a compound having the formula I

$$A\text{-}CO\text{-}N\ R^1R^2.$$

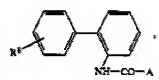
Determination of the scope and content of the prior art

(MPEP 2141.01)

Eicken et al. (US 5,330,995) teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I or formula III



I



II

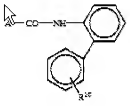
or

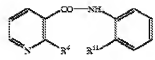
(see the abstract, column 1 lines 1-44, column 10 lines 20-67, and column 11 lines 1-8 and 47-56). The compounds are useful for controlling the fungi Botyris (see the abstract). The compounds can be formulated into compositions in the form of sprayable solutions, powders, suspensions, granules by dusting, broadcasting, etc. (see column 29 lines 60-68). The formulations are produced with a carrier or solvent (see column 30 lines 6-68). The active compound is present in an amount of 0.5 to 95% by weight (see column 32 lines 35-37). The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 32 lines 1-11). The fungicidal composition can be applied at rates from 0.021 to 3 kg, of active compound per ha or 0.001 to 50g per kg of seed (see column 32 lines 35-43). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 32 lines 44-68, and columns 33-34).

Eicken et al. (US 6,143,745) teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I

A-CO-N R^1R^2

(see the abstract, column 2 lines 63-67 and column 3 lines 1-26). The compositions can preferably contain a compound of formula Ia or Ib





(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The active compound is present in an amount of 0.1 to 95% by weight (see column 10 lines 63-65). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48).The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active compound per ha or 0.001 to 50g per kg of seed (see column 10 lines 66-67 and column 11 lines 1-3). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[α-(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[α-(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

Use Example 1 and 2 disclose boscalid (compound 1.2) being applied to the seedlings of paprika and slices of green peppers.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Eicken et al. (US 5,330,995) and Eicken et al. (US 6,143,745) combined do not teach the ratio of the amide compound to a strobilurin. Further, Eicken et al. (US 5,330,995) and Eicken et al. (US 6,143,745) do not teach strobilurin, pyraclostrobin. These deficiencies are cured by the teachings of Asrar et al.

Asrar et al. teach methods of improving the yield and vigor of plants by protection against fungal plant pathogens with a compositions comprising active agents such as strobilurin fungicides, diazole, and triazole fungicides (see the abstract). Examples of strobilurin type fungicides include azoxtstrobin, dimoxystrobin, famoxadone, kresoxim-methyl, metominostrobin, picoxystrobin, pyraclostrobin and trifloxystrobin (see page 5 paragraph 52). The active ingredient can be present in the amount of 0.01 to 95% (see page 17 paragraph 366).

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

One of ordinary skill in the art would have been motivated to use the instant ratio of 20:1 to 1:20 for the compound of formula I and a strobilurin, because Eicken et al. (US 5,330,995) and Eicken et al. (US 6,143,745) suggests compounds of formula I can be combined with strobilurins. Although Eicken et al. (US 5,330,995) and Eicken et al.

(US 6,143,745) do not teach the ration of amide compounds to strobilurins that may be present, Eicken et al. (US 5,330,995) do suggest the compounds of formula I can be present in the amount of 0.5 to 95% and it is already know in the art that strobilurins can be present in the amount of 0.01 to 95% by weight in fungicidal compositions as suggested by Asrar et al.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the instant ratio, because both the instant compounds of formula I and strobilurins can be present in various amounts in fungicidal compositions as suggested by Eicken et al. (US 5,330,995), Eicken et al. (US 6,143,745) and Asrar et al., and it is merely process optimization, in which one of ordinary skill in the art would vary the amount of active components necessary in order to achieve success results.

Although Eicken et al. (US 6,143,745) do not teach strobilurin, pyraclostrobin, it would have been obvious to one of ordinary skill in the art to use pyraclostrobin because it is an obvious variation of strobilurins that can be used in fungicidal compositions as suggested by Asrar et al.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616